#15 Response 10/9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1656
Toshiharu OHBA et al.	)	Examiner: S. Chunduru
Serial No.: 09/368,572	)	Washington, D.C.
Filed: August 5, 1999	)	September 30, 2002
For: PLANT PROMOTER AND METHOD...	)	Docket No.: OHBA=1A
Confirmation No.: 5695	)	

RESPONSE

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action of June 28, 2002 (September 28, 2002, fell on a Saturday), applicants' remarks are presented below.

The Office Action and the cited and applied reference have been carefully reviewed. No claim is allowed. Claims 3-6 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 3-6 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

Applicants submit that the claims are specifically defined by the hybridization conditions. The support for the hybridization conditions can be found in the specification at page

60, lines 15-21. These conditions are "stringent" conditions that exclude hybridization to less homologous nucleic acids. One of skill in the art can confirm a promoter activity of a DNA fragment obtained by hybridization under the above-mentioned conditions according to the procedure as described in the specification at page 44, line 9 to page 50, line 16.

A plant promoter can be obtained by preparing a probe based on the nucleotide sequence of SEQ ID NO: 1, 2, 3, 4, 5, 6, 7 or 8 which are specifically disclosed in the specification, obtaining DNAs having sequences highly homologous to the probe by hybridization under the defined conditions, and selecting therefrom a DNA having a promoter activity as determined by the procedure as described above. Thus, the present specification contains adequate description for those skilled in the art to carry out the claimed invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 3-6 have been rejected under 35 U.S.C. §102(b) as being anticipated by Okazawa et al. J. Biol. Chem. 268(34):25364-25368 (1993). This rejection is respectfully traversed.

Okazawa discloses a nucleotide sequence of a cDNA for a gene encoding endoxyloglucan transferase. Based on sequence alignment, the examiner found a sequence similarity between the 5' portion of the sequence disclosed in Okazawa and the 3' portion of the sequence disclosed in the present application. However, it is pointed out that the nucleotide sequence disclosed in Okazawa is of a cDNA. A cDNA is obtained by reverse transcription from an mRNA. An mRNA is transcribed from a genomic DNA by an upstream promoter.

Therefore, a cDNA is derived from a sequence in genomic DNA downstream from a promoter, and the cDNA does not have a promoter activity in general. Accordingly, Okazawa does not contain any disclosure that demonstrates that the endoxyloglucan transferase cDNA has promoter activity. The definition of "having the promoter activity" as recited in the claims clearly excludes the subject matter disclosed in Okazawa from the scope of the claimed invention. Thus, the presently claimed invention is not anticipated by Okazawa.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,
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